

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of:

Applicant : Tomonori Fujisawa et al.

Title : INFORMING SYSTEM

Serial No. : 10/521,580

Filed : January 18, 2005

Group Art Unit : 2142

Examiner : Jason Recek

APPEAL BRIEF UNDER 37 CFR § 41.37

Date: July 21, 2008

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Dear Sir:

This Appeal Brief is filed pursuant to 37 CFR § 41.37. A credit card authorization form in the amount of \$255.00 is attached herewith for the Appeal brief fee.

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REAL PARTY IN INTEREST

The real party in interest is Kabushiki Kaisha Eighting, a Japanese corporation.

RELATED APPEALS AND INTERFERENCES

Appellants, Appellants' representative, and the Assignee of this application are aware of no other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on, the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1-4 and 6-8 were canceled.

Claims 5 and 9 are pending in the application and stands rejected.

The rejection of claims 5 and 9 are appealed and is set forth in their entirety in the Claims Appendix attached hereto.

STATUS OF AMENDMENTS

The amendments to the claims, presented in the after final amendment filed April 28, 2008, have been entered.

SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 1, supported by the specification as annotated below, recites an informing system comprising:

a service server (130) (see specification, page 6, lines 17-24, and Fig. 1) for relaying communications from an informing person (110) (see specification, page 6, lines 17-24, and Fig. 1) to informed persons (120-122) (see specification, page 6, lines 17-24, and Fig. 1),

terminal devices (111, 112; 121, 122) (see specification, page 6, lines 17-24, and Fig. 1) owned by said informing person and said informed persons connected to each other via a computer network (140) (see specification, page 6, lines 17-24, and Fig. 1), and

means for transmitting to said informed persons informing E-mails each including a URL (Universal Resource Locator) for linking a matter to the informing person, said URL having a document described with a www-compatible language and including a response column corresponding to an access of said informed matter (see specification, page 7, line 3 to page 10, line 5, flowchart of Fig. 3),

wherein said service server (130) comprises means for detecting data concerning said response column transmitted by each of the terminal devices owned by said informed persons, and means for transmitting a result of detection as a reporting E-mail to the terminal device owned by said informing person (see page 12, line 19 to page 13, line 5, flowchart of Fig. 6), and

said reporting E-mail includes a plurality of choices for re-informing methods to the informed persons, said plurality of choices comprising placing a call to a first telephone number of informed persons having not responded, and placing a call to a second telephone number of said informed persons having not responded (see specification, page 14, line 19 to page 15, line 5, flowchart of Fig. 8, block 817).

Independent claim 9, supported by the specification as annotated below, recites an informing system comprising:

a service server (130) for relaying communications from an informing person to informed persons (see specification, page 6, lines 17-24, and Fig. 1),

terminal devices (111, 112; 121, 122) owned by said informing person and said informed persons connected to each other via a computer network (140) (see specification, page 6, lines 17-24, and Fig. 1), and

means for transmitting to said informed persons informing E-mails each including a URL (Universal Resource Locator) for linking a matter to the informing person (see specification, page 9, lines 1-2), said URL having a document described with a www-compatible language and including a response column corresponding to an access of said informed matter (see specification, page 10, lines 18-25),

wherein said service server comprises means for detecting data concerning said response column transmitted by each of the terminal devices owned by said informed persons, and means for transmitting a result of detection as a reporting E-mail to the terminal device owned by said informing person (see page 12, line 19 to page 13, line 5, and flowchart of Fig. 6), and

means for preparing a list of informed persons not having checked a transmitted message, and means for periodically reporting the list to the informing person (see page 12, line 9 to page 13, and flowchart of Fig. 6).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

35 U.S.C. § 103(a)

Whether claims 5 and 9 are unpatentable under 35 U.S.C. 103(a) over *Orime et al.* (JP 2002-183365) in view of *Hasebe* (JP 2000-207300 A).

ARGUMENT

Claim 5 is patentable under 35 U.S.C. §103(a)

Claim 5 recites transmitting a reporting E-mail to an informing person, wherein the E-mail includes a plurality of choices for re-informing informed persons who have not responded, the plurality of choices including placing a call to a first telephone number of informed persons having not responded, and placing a call to a second telephone number of said informed persons having not responded. The final Office Action acknowledges that the disclosure of *Orime* is incomplete and relies upon *Hasebe* to allegedly remedy the deficiencies of *Orime*.

Specifically, the Office Action acknowledges that *Orime* fails to disclose the "wherein said reporting E-mail includes a plurality of choices for re-informing methods...choices comprising placing a call to a first telephone." The Office Action alleges that *Hasebe*, at paragraphs 37-45, makes up for this deficiency by teaching a Web browser that displays information and gives a plurality of choices for re-informing. Appellants respectfully disagree.

Appellants submit that not only does the applied art fail to disclose, teach or suggest all of Applicants' recited claim

features, but in addition fails to present any apparent reason to combine references or modify prior art to create the Applicants' allegedly obvious claim elements.

The disclosures of Orime and Hasebe do not teach or suggest all of Applicants' claim features

In the paragraphs cited by the Examiner, *Hasebe* describes the operation of server 13E that sends a message by e-mail to members through specific steps, and if no reply is returned to the server within a specific period, these members that do not reply can be listed at the server.

However, nowhere does *Hasebe* appear to disclose, teach, or suggest transmitting a reporting e-mail to the informer with a plurality of choices for re-informing a member. Appellants respectfully submit that Appellants' method of transmitting an e-mail to the informer is distinguished from listing non-responding members on a server.

The disclosures of Orime and Hasebe, taken as a whole, do not suggest Applicants' claimed method

The Office Action further alleges that, based upon paragraphs 3-4 of *Orime* that appears to disclose previous management done by telephone and a stored telephone number of an invitee, and *Hasebe* that describes resending e-mails to members, it would have been obvious to combine the teachings of *Orime* and *Hasebe* to teach resending an invitation via telephone. Appellants respectfully submit that the issue is not whether the combination of *Orime* and *Hasebe* teaches the resending of an invitation via e-mail or telephone, the distinguish feature of Appellants' method is the sending of a reporting e-mail to the informer, the e-mail

including the options available to the informer for contacting a non-responding member either by e-mail or telephone.

Orime may disclose a table of attendants showing the telephone number, but nowhere does *Orime* disclose sending an E-mail to the informer showing a list of non-respondents along with the telephone numbers of the non-respondent members.

Applicants respectfully submit, therefore, that claim 5 is patentable not only due to the failure of *Orime* and *Hasebe* to disclose, teach or motivate all recited features of the claims, but are also patentable based the disclosures of *Orime* and *Hasebe*, that when taken as a whole, do not suggest Applicants' claimed method of transmitting an e-mail to the informer with a plurality of choices for notifying a non-respondent user.

Accordingly, withdrawal of this rejection is respectfully requested.

Claim 9 is patentable under 35 U.S.C. §103(a)

Claim 9 is similar to claim 5, reciting, *inter alia*:

"wherein said service server comprises means for detecting data concerning said response column transmitted by each of the terminal devices owned by said informed persons, and means for transmitting a result of detection as a reporting E-mail to the terminal device owned by said informing person, and

means for preparing a list of informed persons not having checked a transmitted message, and means for periodically reporting the list to the informing person." (Emphasis added).

As presented above regarding claim 5, nowhere does *Hasebe* appear to disclose, teach, or suggest transmitting a reporting e-mail to the informer with a plurality of choices for re-informing

a member. Indeed, nowhere do either *Orime* or *Hasebe* disclose, teach, or suggest sending any e-mail report to the informer. Appellants respectfully submit that Appellants' method of transmitting an e-mail to the informer is distinguished from the methods of *Orime* and *Hasebe*.

Furthermore, as recited in claim 9, the list of informed persons not having checked a transmitted message is prepared, and the list is periodically sent to the informing person.

In *Hasebe*, it is disclosed that the resenting an invitation if the member does not response. However, it is not disclosed or suggested that the list of unattended persons is periodically sent to the organizer or informing person. *Orime* does not disclose or suggest the list of unattended persons.

Accordingly, the rejection of claim 9 under 35 U.S.C. §103(a) is improper and Appellant respectfully submits, therefore, that independent claim 9 is patentable over the applied art and the rejection should be reversed.

CONCLUSION

Accordingly, Appellants respectfully submits that the rejection of claims 5 and 9 are in error, and request that the final rejection be reversed.

Respectfully submitted,

KANESAKA BERNER AND PARTNERS

By Manabu Kanesaka
Manabu Kanesaka
Reg. No. 31,467
Agent for Appellant

1700 Diagonal Road, Suite 310
Alexandria, VA 22314
(703) 519-9785

CLAIMS APPENDIX

5. A informing system comprising:

a service server for relaying communications from an informing person to informed persons,

terminal devices owned by said informing person and said informed persons connected to each other via a computer network, and

means for transmitting to said informed persons informing E-mails each including a URL (Universal Resource Locator) for linking a matter to the informing person, said URL having a document described with a www-compatible language and including a response column corresponding to an access of said informed matter,

wherein said service server comprises means for detecting data concerning said response column transmitted by each of the terminal devices owned by said informed persons, and means for transmitting a result of detection as a reporting E-mail to the terminal device owned by said informing person, and

said reporting E-mail includes a plurality of choices for re-informing methods to the informed persons, said plurality of choices comprising placing a call to a first telephone number of informed persons having not responded, and placing a call to a second telephone number of said informed persons having not responded.

9. A informing system comprising:

a service server for relaying communications from an informing person to informed persons,

terminal devices owned by said informing person and said informed persons connected to each other via a computer network, and

means for transmitting to said informed persons informing E-mails each including a URL (Universal Resource Locator) for linking a matter to the informing person, said URL having a document described with a www-compatible language and including a response column corresponding to an access of said informed matter,

wherein said service server comprises means for detecting data concerning said response column transmitted by each of the terminal devices owned by said informed persons, and means for transmitting a result of detection as a reporting E-mail to the terminal device owned by said informing person, and

means for preparing a list of informed persons not having checked a transmitted message, and means for periodically reporting the list to the informing person.

EVIDENCE APPENDIX

No copies of evidence are appended hereto.

RELATED PROCEEDINGS APPENDIX

No copies of decisions are appended hereto.